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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,942	03/05/2002	Robert L. Campbell	41552	8014
26253	7590	07/11/2006	EXAMINER BRUSCA, JOHN S	
DAVID W. HIGHET, VP AND CHIEF IP COUNSEL BECTON, DICKINSON AND COMPANY 1 BECTON DRIVE, MC 110 FRANKLIN LAKES, NJ 07417-1880			ART UNIT 1631	PAPER NUMBER

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/087,942

Applicant(s)

CAMPBELL ET AL.

Examiner

John S. Brusca

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
 - b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on 13 June 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2-15 and 18-30.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. Other: See Continuation Sheet.

John S. Brusca
Primary Examiner
Art Unit: 1631

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the rejection for lack of enablement of claim 30, on page 10 of their remarks, the applicants point to three sections of the specification in support of enablement for the claimed subject matter of claim 30, which is drawn to measurement of the effect of a peptide library on production of antibiotics, steroids, carbohydrates, lipids, and nucleic acids in cells in media treated with the peptide library. In the locations pointed to at page 6, lines 5-22 and page 17 lines 6-19, the specification merely recites the claimed subject matter without providing enabling support. At the specification page 44 line 27 to page 45 line 2 the specification merely discusses types of compounds applied to cells in media, but does not discuss types of compounds whose production is affected by applied compounds. The applicants have failed to provide any evidence or arguments that the claimed subject matter of claim 30 can be used by one of skill in the art, and the rejection under 35 U.S.C. 112, first paragraph is maintained.

Regarding the rejections under 35 U.S.C. 103:

The applicants state on page 20 of their remarks that Lam et al. does not use a predetermined set of compounds, however Lam states in the abstract that they employ a library of bio-oligomers of defined size and known composition, and exemplify a random peptide library. The instant specification exemplifies a peptide library at page 12 and elsewhere, and the claims do not have a limitation that excludes use of a random peptide library.

On pages 20-21 of their remarks, the applicants state that Lam et al. does not perform a second round of screening of compounds that are not in the first test library, as claimed, however Lam et al. shows a second round of screening of variants of the first test library in column 17, lines 18-24.

The applicants state on pages 21-22 of their remarks that Zheng analyzes peptides with known properties, and the claimed subject matter uses an unbiased selection of compounds, but the claimed subject matter does not have limitations that exclude analysis of peptides with known properties.

The applicants state on pages 22-23 that Zheng and Bause do not show the claimed use of space filling analysis, however the combination of the peptide library method of Lam et al. with the QSAR analysis of peptides of Zheng and the space filling analysis of peptides of Bause make obvious the claimed subject matter for reasons of record. The applicants further argue there is a lack of motivation to combine the references on pages 23-28 of their remarks, however the motivation was shown in the Final Office action as allowing improved analysis of the members of the peptide library of Lam et al. The rejections under 35 U.S.C. 103 are maintained.

Continuation of 13. Other: Regarding the non-consideration of Information Disclosure Statement of 28 April 2006:

The information disclosure statement filed 28 April 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it fails to comply with 37 CFR 1.97(d) because it was filed after a final rejection and lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).